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10/023,150	12/17/2001	Naoyuki Matsumoto	CANO:041	3168

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EXAMINER

SCHLACK, SCOTT A

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,150

Applicant(s)

MATSUMOTO, NAOYUKI

Examiner

Scott Schlack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims **21-30** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. Regarding claims **21-30**, the phrase "A document delivery program executed on a computer" does not explicitly identify a physical "thing". Programs are neither computer components nor statutory processes, as they are not "acts" being performed. Therefore, the examiner recommends that claims 21-30 be withdrawn or that the phrase, "A document delivery program executed on a computer" be changed to "a computer-readable medium, comprising a document delivery program". These revisions are necessary for the claims to be considered.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 6-13, 16-23 and 26-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Eldridge et al. (US 6,397,261).

7. With respect to claim 1, Eldridge et al. discloses a document delivery apparatus (Token Enabled Servers 126 comprising Document Delivery Server 138 of Fig 1) connected via a network (Intranet 116 and Internet 122 of Fig 1) to a plurality of external devices (102, 110, 104, 112, 106, 107, 118 and 126 of Fig 1) and a plurality of servers (104, 112, 106, 107 and 126 of Fig 1), comprising: delivery setting means for making delivery settings (col 5, lines 34-46 and 442 of Fig 8) for document information received from the external devices (118 of Fig 1); receiving means for receiving document information from the external devices (104 of Fig 1 and 436 of Fig 8); and delivery means for determining a delivery destination for the received document information, based on the delivery settings (col 5, lines 34-46 and 422 of Fig 8), and for delivering the received document information to the determined delivery destination (442 of Fig 8).

The examiner interprets a delivery setting means for making delivery settings as being necessarily inherent to the process of delivering the document, via an appropriate printer driver, to a selected document processing device (col 5, lines 34-46). The examiner further notes that in selecting the appropriate printer driver for a given document-processing device, the delivery servers (128 and 138 of Fig 1) make and utilize delivery settings.

8. Claim **11** recites identical features as claim 1 except claim 11 is a method claim. Thus, arguments similar to that presented above for claim 1 are also equally applicable to claim 11.

9. Claim **21** recites identical features as claim 1 except claim 21 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 1 are also equally applicable to claim 21. The examiner notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

10. Claim **31** recites identical features as claim 1 except claim 31 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 1 are also equally applicable to claim 31. The examiner notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

11. With respect to claim **32** the examiner notes identical features to claim 1. Therefore, the explanation given above for claim 1 is also valid for claim 32.

12. With respect to claim **2**, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein the delivery destination (col 5, lines 34-45 and 442 of Fig 8) comprises at least one selected from the group consisting of a document management server that manages documents (Network File Server 104 of Fig 1), a mail server that delivers electronic mails (Network Email Server 112 of Fig 1), and an external device that executes jobs (Printer 102 of Fig 1).

13. Claim **12** recites identical features as claim 2 except claim 12 is a method claim. Thus, arguments similar to that presented above for claim 2 are also equally applicable to claim 12.

14. Claim **22** recites identical features as claim 2 except claim 22 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 2 are also equally applicable to claim 22. The examiner notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

15. With respect to claim **3**, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein the delivery destination for the received document information comprises a document management server that manages documents (104 Network File Server 104 and Shared Document Server 134 of Fig 1), and said delivery means comprises control means for delivering additional information acquired from the external device together with the document information to said document management server as index information, and registering the document information and the index information in said document management server (col 5, lines 34-46).

The examiner notes that the Document Delivery Servers (128 and 138 of Fig 1) store documents to the Network File Server or the Shared Document Server (104 and 134 of Fig 1) from external devices such as a fax machine or a scanner (col 5, lines 41-45). The examiner further notes that in order to retrieve one of these documents utilizing token information, the document stored in the document management servers need to have reference token information. The examiner interprets this additional reference

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information to be equivalent to index information, which is registered on the Document Delivery Servers in order to facilitate extraction of documents via tokens (col 7, lines 41-58).

16. Claim **13** recites identical features as claim 3 except claim 13 is a method claim. Thus, arguments similar to that presented above for claim 3 are also equally applicable to claim 13.

17. Claim **23** recites identical features as claim 3 except claim 23 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 3 are also equally applicable to claim 23. The examiner notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

18. With respect to claim **6**, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein the delivery settings are set (418 and 442 of Fig 8) for each of the plurality of external devices (118 of Fig 1) that are transmission sources of the document information (col 5, lines 34-45).

The examiner interprets the document information as being equivalent to the document tokens, which are sent from the mobile computing devices (118 of Fig 1) and further notes that it is necessarily inherent that the document delivery apparatus (Token Enabled Servers 126 comprising Document Delivery Server 138 of Fig 1), which receives these tokens, set the corresponding delivery settings.

19. Claim **16** recites identical features as claim 6 except claim 16 is a method claim. Thus, arguments similar to that presented above for claim 6 are also equally applicable to claim 16.

20. Claim **26** recites identical features as claim 6 except claim 26 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 6 are also equally applicable to claim 26. The examiner notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

21. With respect to claim **7**, Eldridge et al. discloses a document delivery apparatus according to claim 1, comprising control means for controlling said delivery setting means such that delivery settings are made in accordance with instructions from any of said external devices (118 of Fig 1 and col 5, lines 34-45).

The examiner notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) control delivery setting means, such that delivery settings are made in accordance with instructions (tokens) from any of said external devices (118 of Fig 1 and col 5, lines 34-45).

22. Claim **17** recites identical features as claim 7 except claim 17 is a method claim. Thus, arguments similar to that presented above for claim 7 are also equally applicable to claim 17.

23. Claim **27** recites identical features as claim 7 except claim 27 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 7 are also equally applicable to claim 27. The examiner notes that it is necessarily inherent

that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

24. With respect to claim **8**, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein the document information comprises information selected from the group consisting of received fax document (Network Fax Server 106 of Fig 1) information and scan document (Scanner 110 of Fig 1) information (col 5, lines 41-45).

25. Claim **18** recites identical features as claim 8 except claim 18 is a method claim. Thus, arguments similar to that presented above for claim 8 are also equally applicable to claim 18.

26. Claim **28** recites identical features as claim 8 except claim 28 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 8 are also equally applicable to claim 28. The examiner notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

27. With respect to claim **9**, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein, when the document information is in a format different from one handled by the delivery destination, said delivery means converts the format of the document information to the one handled by the delivery destination (440 of Fig 8 and col 12, lines 53-62) and then delivers the document information to the delivery destination (442 of Fig 8 and col 12, lines 62-67).

28. Claim **19** recites identical features as claim 9 except claim 19 is a method claim. Thus, arguments similar to that presented above for claim 9 are also equally applicable to claim 19.

29. Claim **29** recites identical features as claim 9 except claim 29 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 9 are also equally applicable to claim 29. The examiner notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

30. With respect to claim **10**, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein the external devices (102, 110, 104, 112, 106, 107, 118 and 126 of Fig 1) have at least one function selected from the group consisting of an image reading function (Scanner 110 of Fig 1), and a facsimile transmission and reception function (Network Fax Server 106 of Fig 1).

The examiner interprets the Scanner (110 of Fig 1) to inherently have an image reading function.

31. Claim **20** recites identical features as claim 10 except claim 20 is a method claim. Thus, arguments similar to that presented above for claim 10 are also equally applicable to claim 20.

32. Claim **30** recites identical features as claim 10 except claim 30 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 10 are also equally applicable to claim 30. The examiner notes that it is necessarily

inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

Claim Rejections - 35 USC § 103

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

34. Claims **4**, **14** and **24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (US 6,397,261) in view of Wells et al. (US 5,999,601).

35. With respect to claim **4**, Eldridge et al. discloses a document delivery apparatus according to claim 3, wherein the received document information comprises a document received by fax (fax server 106 of Fig 1 and col 5, lines 41-45).

The examiner notes that the Document Delivery Servers (128 and 138 of Fig 1) store documents to the Network File Server or the Shared Document Server (104 and 134 of Fig 1) from external devices such as a fax server or a scanner (col 5, lines 41-45)

Eldridge et al. does not disclose wherein the additional information comprises at least one selected from the group consisting of information on a transmitter of the received fax document, reception time information relating to the received fax document, and document page number information.

Wells et al. does disclose stored facsimile information comprising reception time information relating to the received fax document (col 4, lines 65-67 and col 5, lines 1-4).

Eldridge et al. and Wells et al. are analogous art, because they are from the same field of endeavor, namely Image Data Communications.

At the time of the invention, it would have been obvious for one skilled in the art to combine Eldridge et al's document delivery apparatus according to claim 3, wherein the received document information comprises a document received by fax, with Wells et al's stored facsimile information comprising reception time information relating to the received fax document such that the additional information disclosed in claim 3 comprises the reception time information.

The suggestion or motivation for doing so would have been to explicitly state that reception time information is included in the additional information disclosed in claim three.

36. Claim **14** recites identical features as claim 4 except claim 14 is a method claim. Thus, arguments similar to that presented above for claim 4 are also equally applicable to claim 14.

37. Claim **24** recites identical features as claim 4 except claim 24 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 4 are also equally applicable to claim 24. The examiner notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

38. Claims **5**, **15** and **25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (US 6,397,261) in view of Adamske et al. (US 6,615,234)

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39. With respect to claim 5, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein the delivery destination for the received document information comprises a document management server (104 Network File Server 104 and Shared Document Server 134 of Fig 1) that manages documents, and wherein the document delivery apparatus (Token Enabled Servers 126 comprising Document Delivery Server 138 of Fig 1 and col 5, lines 41-45) comprises control means.

Eldridge et al. does not disclose wherein the document delivery apparatus comprises control means operable when the received document information is delivered to the document management server, for notifying by electronic mail to at least one predetermined electronic mail address that the document information has been registered.

Adamske et al. does disclose notifying by electronic mail to at least one predetermined electronic mail address that the document information has been delivered (col 4, lines 30-39).

Eldridge et al. and Adamske et al. are analogous art, because they are from the same field of endeavor, namely Document Delivery.

At the time of the invention, it would have been obvious for one skilled in the art to combine Eldridge et al's document delivery apparatus according to claim 1, wherein the delivery destination for the received document information comprises a document management server, with Adamske et al's notifying by electronic mail to at least one predetermined electronic mail address that the document information has been delivered.

The suggestion or motivation for doing so would have been to explicitly state that an email notification is sent out to at least one predetermined electronic mail address that the document information has been registered.

40. Claim **15** recites identical features as claim 5 except claim 15 is a method claim. Thus, arguments similar to that presented above for claim 5 are also equally applicable to claim 15.

41. Claim **25** recites identical features as claim 5 except claim 25 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 5 are also equally applicable to claim 25. The examiner notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

Conclusion

42. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sastry et al. (US 6,687,877) discloses transmitting web-based document annotations. Ogawa et al. (US 2001/0043594) discloses an information processing apparatus. Iida (US 6,785,023) discloses a network facsimile apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Schlack whose telephone number is 571-272-7954. The examiner can normally be reached on 9-5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on 571-272-7471. The fax phone


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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Note to the applicant: Art Unit 2624 has been redesignated as Art Unit 2625 due to organizational restructuring with the USPTO.


Scott A. Schlack


KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER